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OIPE AUG 14 2007 PATENT & TRADEMARK OFFICE

Mail Stop Appeal Brief-Patents
Confirmation No. 2402

In re application of	: Andres SANCHEZ	Attorney Docket No. <u>P18459</u>
Serial No.	: 09/407,174	Group Art Unit : 2642
Filed	: September 28, 1999	Examiner : W. J. Deane, Jr.
For	: METHOD FOR MANAGING INFORMATION IN A TELEPHONE AND TELEPHONE FOR MANAGING INFORMATION	

Mail Stop Appeal Brief-Patents
Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop <u>Appeal Brief - Patents</u>
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Transmitted herewith is an **Appeal Brief under 37 C.F.R. § 41.37** in the above-captioned application.
___ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
___ A Request for Extension of Time.
_X_ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 23	*24	0	X25=	$	x 50=	$0.00
Indep. Claims: 5	**5	0	X100=	$	X200=	$0.00
Multiple Dependent Claims Presented		+180=	$	+360=	$0.00	
Extension Fees for ___ Month(s)				$		$0.00
* If less than 20, write 20 ** If less than 3, write 3		Total:	$	Total:	$0.00	

___ Please charge my Deposit Account No. 19-0089 in the amount of $_____.
N/A A Check in the amount of $_____ to cover the filing/extension fee(s) is included.
_X_ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.
   _X_ Any additional filing fees required under 37 C.F.R. 1.16.
   _X_ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).

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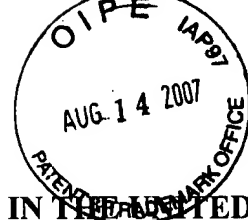
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant	: Andres SANCHEZ	Group Art Unit: No.	2642
Application No	: 09/407,174	Examiner: W. J. Deane, Jr.	
Filed	: September 28, 1999	Confirmation No.: 2402	
For:	: METHOD FOR MANAGING INFORMATION IN A TELEPHONE AND TELEPHONE FOR MANAGING INFORMATION		

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop **Appeal Brief - Patents**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This appeal is from the Examiner's at least twice rejection of claims 1, 2, and 4 – 24 as set forth in the Office Action of December 14, 2006.

Subsequently to the filing of Appellant's Appeal Brief of August 14, 2006 and to the filing of Appellant's Supplemental Appeal Brief of October 2, 2006, the Examiner reopened prosecution in the December 14, 2007 Office Action. In response to this Office Action, Appellant filed a Notice of Appeal on June 14, 2007. Accordingly, the instant Appeal Brief is being timely submitted by the initial due date of August 14, 2007.

As the requisite fee under 37 C.F.R. 1.17(c) in the amount of $ 500.00 for the filing of the Appeal Brief was previously paid on August 14, 2006, Appellant submits no fee is due at this time. However, if for any reason a fee is deemed necessary, the undersigned authorizes the charging of any filing fees for the Appeal Brief and/or any necessary extension of time fees to Deposit Account No. 19 - 0089.

(1)   **REAL PARTY IN INTEREST**

The real party in interest is Fenmore International, Ltd. Of Tortola, British Virgin Islands, by

an assignment recorded in the U.S. Patent and Trademark Office on January 14, 2000 at Reel 010522

and Frame 0720.

(2)   RELATED APPEALS AND INTERFERENCES

No related appeals and/or interferences are pending.

(3)   STATUS OF THE CLAIMS

Claims 1, 2, and 4 – 24 stand finally rejected.

(4)   STATUS OF THE AMENDMENTS

As the instant application is not under a final rejection, all amendments presented during prosecution of this application have been entered and considered by the Examiner. Moreover, a *Listing of Claims* identifying the current status of the claims on appeal is provided.

(5)   SUMMARY OF CLAIMED SUBJECT MATTER

The instant invention is directed to an electronic telephone apparatus and a method for managing pieces of information (data) relating to telephone number lists stored in the telephone, in which the display and use of the data is allowed only after an access code is inputted into the telephone. (Page 1, lines 9 - 12).

The following descriptions are made with respect to the independent claim and include references to particular parts of the specification. As such, the following is merely exemplary and is not a surrender of other aspects of the present invention that are also enabled by the present specification and that are directed to equivalent structures or methods within the scope of the claims.

Independent claim 1 is directed to a method for managing telephone data used with a telephone. (Page 8, line 13; and Figure 2). The method includes storing telephone data related to at least one of incoming and outgoing telephone calls in at least one of a public call and private call list (Page 8, lines 18 – 21; and Figure 2), the public call list being accessible to any user during operation of the telephone. (Page 9, lines 14 – 17; and Figure 2). The method further includes limiting a user's access to the public telephone data in the public call list, until such time as the user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the public call list and to private telephone data in the private call list of private telephone data that is associated with the inputted personal secret access code. (Page 9, line 19 – 24; and Figure 3). Both the private call list and the public call list are stored in the telephone. (Page 9, lines 7 – 12; lines 14 – 17; and Figure 2).

Independent claim 11 is directed to a telephone that manages integrally stored telephone data. The telephone includes a memory that stores telephone data related to at least one of

incoming and outgoing telephone calls (Page 8, lines 3 and 4; lines 13 and 14; and Figures 1 and 2), a public list containing public telephone data is accessible to all users during operation of the telephone (Page 9, line 14 – 17; Figure 2), and a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code. (Page 9, lines 7 – 12; Figure 2). Access to said stored telephone data is limited to said public list containing public telephone data, until such time as the user enters said personal secret access code, and after entering the personal secret access code, the user has access to said public telephone data contained in said public list and to a private list containing private telephone data that is associated with said inputted personal secret access code. (Page 9, lines 19 – 24; and Figure 3). Both the private telephone data and the public telephone data are stored in the telephone. (Page 9, lines 7 – 12; lines 14 – 17; and Figure 2).

Independent claim 16 is directed to a method for managing data used with a telephone. The method includes entering a personal secret access code into the telephone by a user of the telephone (Page 9, lines 19 – 24; and Figure 3), creating a private list containing telephone data associated with the personal secret access code entered by the user, the telephone data, composed of information related to incoming and outgoing telephone calls, collected and accessible only after entry of the associated personal secret access code (Page 11, lines 4 - 9; and Figure 3), and creating a public list accessible to all users during operation of the telephone which contains telephone data, composed of incoming and outgoing telephone calls, collected and accessible prior to entering the personal secret access code. (page 9, lines 14 – 17; and Figure 2). The telephone numbers in both the private list and the public list are stored in the telephone. (Page 9, lines 7 – 12; lines 14 – 17; and Figure 2).

Independent claim 23 is directed to method for managing telephone data using a

telephone that can be used by a plurality of users. The method includes storing in the telephone

public telephone data related to at least one of incoming and outgoing telephone calls in a public

list accessible to all users(Page 9, lines 14 – 17; and Figure 2), and storing in the telephone, for

each of the plurality of users, private telephone data related to at least one of incoming and

outgoing telephone calls in a respective private list (Page 9, lines 7 – 12; and Figure 2). Each

respective private list is associated with a personal secret access code. (Page 9, lines 19 – 24;

and Figure 3). The method also includes allowing each of the plurality of users access to the

public type of telephone data (Page 9, lines 16 and 17; and Figure 2), preventing each of the

plurality of users from accessing any of the private telephone data until a valid personal secret

access code is entered (Page 9, lines 10 – 12; and Figure 2), allowing the user entering the valid

personal secret access code to access the private telephone data associated with the valid personal

secret access code (Page 9, lines 23 and 24; and Figure 3), and allowing another user entering

another valid personal secret access code to access the private telephone data associated with

another valid personal secret access code. (Page 16, lines 4 – 6; and Figure 5). Each personal

secret access code is distinct. (Page 10, lines 14 and 15; and Figure 3).

(6)   **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

(A)   Claims 1, 2, 4, 11, 12, 16, 18, 23, and 24 are Rejected Under 35 U.S.C. § 102(b)

as being Anticipated by SUSSMAN (U.S. Patent No. 5,483,586); and

(B)   Claims 5 – 10, 13 – 15, 17, and 19 – 22 are Rejected Under 35 U.S.C §103(a)

as being Unpatentable over SUSSMAN in view of AUSTIN (U.S. Patent No.

6,259,908).

(7)   **ARGUMENT**

(A)   **The Rejection of Claims 1, 2, 4, 11, 12, 16, 18, 23, and 24 Under 35 U.S.C. §**

103(a) As Anticipated by SUSSMAN is in Error, the Rejection Should be Reversed,

and the Application Should be Remanded to the Examiner.

The Examiner asserts SUSSMAN discloses a method of managing telephone data and

storing telephone data related to at least one of incoming and outgoing telephone calls in at least

one of a public call and private call list, the public call list (memory 9) being accessible to any

user and limiting a user's access to the public telephone data in the public call list until such time

as the user inputs a personal secret access code, whereupon the user has access to both public

data in the public call list and private telephone data (memory 10) in the private call list

associated with the personal secret access code. The Examiner further asserts, as the claim does

not recite the system captures data of an incoming or outgoing call, the data stored in SUSSMAN

is related to incoming or outgoing calls. Appellants traverse the Examiner's assertions.

A claim is anticipated only if each and every element as set forth in the claim is found,

either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union*

Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *See* MPEP

§2131. Appellants submit that the applied art does not show each and every feature of the

claimed invention.

Independent Claim 1:

Appellant's independent claim 1 recites, *inter alia,* storing telephone data *related to at*

least one of incoming and outgoing telephone calls in at least one of a public call and private call

list, *the public call list being accessible to any user during operation of the telephone,* and

limiting a user's access to the public telephone data in the public call list, until such time as the

user of the telephone inputs a personal secret access code, after which, the user has access to the

public telephone data in the public call list and to private telephone data in the private call list of

private telephone data that is associated with the inputted personal secret access code. Appellant

submits that SUSSMAN fails to render unpatentable at least the above-noted features of the

invention.

Appellant notes SUSSMAN discloses an on-line subscriber telephone directory in which

a central directory service provider maintains a local directory and forwards directory updates to

subscribers at predefined intervals and times. The directory is stored in a memory 9 and can be

accessed by a user to select an individual or business to call. Moreover, a memory 10 is provided

to store a user's on-line personal telephone directories, and can include a list of frequently used

telephone numbers. This list is populated by the user browsing the downloaded read-only

directory 9, which is maintained by the Central Telephone Directory Service Provider 1, and

selects entries to add to a personal list in memory 10. *See* SUSSMAN, Column 6, lines 40 – 47.

From the disclosure of SUSSMAN, directory 9 is populated with data downloaded from a

service provider's remote location. Thus, there is no arguable disclosure in SUSSMAN that the

data stored in directory 9 is related to at least one of incoming or outgoing calls. Moreover,

while SUSSMAN discloses the user can direct the telephone to dial any number listed in

directories 9 and 10, there is no arguable disclosure of storing telephone data related to at least

one of incoming or outgoing calls in memory 9, which is provided solely to receive directory data

from the service provider.

Further, Appellant submits SUSSMAN's memory 9 fails to provide any arguable

disclosure of a public call list, composed of stored telephone data related to at least one of

incoming and outgoing telephone calls, being accessible to any user during operation of the

telephone, as recited in at least independent claim 1. Again, Appellant notes memory 9 of

SUSSMAN is directory information downloaded from a directory service provider and there is

no disclosure this memory stores data related to incoming and/or outgoing telephone calls.

Moreover, Appellant notes, while SUSSMAN indicates the user directory information

can be prevented from display until entry of an appropriate identification code and password,

there is no arguable disclosure whether the on-line directory stored in memory 9 is accessible

before entry of the appropriate identification code and password. As SUSSMAN is silent as to

whether the telephone is operational and/or whether the on-line directory stored in memory 9 is

accessible before entry of an appropriate code and password, Appellant submits this document

cannot anticipate the invention recited in at least independent claim 1.

Still further, as Appellant has shown memory 9 of SUSSMAN does not even arguably

correspond to the recited public call list, i.e., memory 9 of SUSSMAN is not populated by data

related to incoming and/or outgoing calls, Appellant submits there is no arguable disclosure by

SUSSMAN of a public call list being accessible to any user during operation of the telephone, as

recited in at least independent claim 1. In fact, Appellant submits SUSSMAN does not even

arguably disclose separate public and private call lists, as recited in at least independent claim 1.

Thus, Appellant submits the above-noted features of the present invention, which are

recited in at least independent claim 1, are neither expressly nor implicitly disclosed by

SUSSMAN. Because SUSSMAN fails to disclose at least the above-noted features of the instant

invention, Appellant submits the Examiner has failed to establish an adequate evidentiary basis

to support an anticipation rejection under 35 U.S.C. § 102(b).

Independent Claim 11:

Appellant's independent claim 11 recites, *inter alia, a public list containing public*

telephone data is accessible to all users during operation of the telephone, and a personal secret

access code entry device that enables a user of the telephone to enter a personal secret access

code, in which *access to said stored telephone data is limited to said public list containing public*

telephone data, until such time as the user enters said personal secret access code, and after

entering the personal secret access code, the user has access to said public telephone data

contained in said public list and to a private list containing private telephone data that is

associated with said inputted personal secret access code. Appellant submits that SUSSMAN

fails to render unpatentable at least the above-noted features of the invention.

Appellant notes SUSSMAN discloses an on-line subscriber telephone directory in which

a central directory service provider maintains a local directory and forwards directory updates to

subscribers at predefined intervals and times. The directory is stored in a memory 9 and can be

accessed by a user to select an individual or business to call. Moreover, a memory 10 is provided

to store a user's on-line personal telephone directories, and can include a list of frequently used

telephone numbers. This list is populated by the user browsing the downloaded read-only

directory 9, which is maintained by the Central Telephone Directory Service Provider 1, and

selects entries to add to a personal list in memory 10. *See* SUSSMAN, Column 6, lines 40 – 47.

From the disclosure of SUSSMAN, directory 9 is populated with data downloaded from a

service provider's remote location. Thus, there is no arguable disclosure in SUSSMAN that the

data stored in directory 9 is related to at least one of incoming or outgoing calls. Moreover,

while SUSSMAN discloses the user can direct the telephone to dial any number listed in

directories 9 and 10, there is no arguable disclosure of storing telephone data related to at least

one of incoming or outgoing calls in memory 9, which is provided solely to receive directory data

from the service provider.

Further, Appellant submits SUSSMAN's memory 9 fails to provide any arguable disclosure of a public call list, composed of telephone data related to at least one of incoming and outgoing telephone calls stored in a memory, being accessible to all users during operation of the telephone, as recited in at least independent claim 11. Again, Appellant notes memory 9 of SUSSMAN is directory information downloaded from a directory service provider and there is no disclosure this memory stores data related to incoming and/or outgoing telephone calls.

Moreover, Appellant notes, while SUSSMAN indicates the user directory information can be prevented from display until entry of an appropriate identification code and password, there is no arguable disclosure whether access is limited to the on-line directory stored in memory 9 until entry of the appropriate identification code and password. As SUSSMAN is silent as to whether the telephone is operational and/or whether the on-line directory stored in memory 9 is accessible before entry of an appropriate code and password, Appellant submits this document cannot anticipate the invention recited in at least independent claim 11.

Still further, as Appellant has shown memory 9 of SUSSMAN does not even arguably correspond to the recited public call list, i.e., memory 9 of SUSSMAN is not populated by data related to incoming and/or outgoing calls, Appellant submits there is no arguable disclosure by SUSSMAN of a public call list being accessible by all users during operation of the telephone, as recited in at least independent claim 11. In fact, Appellant submits SUSSMAN does not even arguably disclose separate public and private call lists, as recited in at least independent claim 11.

Thus, Appellant submits the above-noted features of the present invention, which are recited in at least independent claim 11, are neither expressly nor implicitly disclosed by SUSSMAN. Because SUSSMAN fails to disclose at least the above-noted features of the instant invention, Appellant submits the Examiner has failed to establish an adequate evidentiary basis

to support an anticipation rejection under 35 U.S.C. § 102(b).

Independent Claim 16:

Appellant's independent claim 16 recites, *inter alia*, creating *a private list containing*

telephone data associated with the personal secret access code entered by the user, the telephone

data, composed of information related to incoming and outgoing telephone calls, *collected and*

accessible only after entry of the associated personal secret access code, and *creating a public*

list accessible to all users during operation of the telephone which contains telephone data,

composed of incoming and outgoing telephone calls, *collected and accessible prior to entering*

the personal secret access code. Appellant submits that SUSSMAN fails to render unpatentable

at least the above-noted features of the invention.

Appellant notes SUSSMAN discloses an on-line subscriber telephone directory in which

a central directory service provider maintains a local directory and forwards directory updates to

subscribers at predefined intervals and times. The directory is stored in a memory 9 and can be

accessed by a user to select an individual or business to call. Moreover, a memory 10 is provided

to store a user's on-line personal telephone directories, and can include a list of frequently used

telephone numbers. This list is populated by the user browsing the downloaded read-only

directory 9, which is maintained by the Central Telephone Directory Service Provider 1, and

selects entries to add to a personal list in memory 10. *See* SUSSMAN, Column 6, lines 40 – 47.

From the disclosure of SUSSMAN, directory 9 is populated with data downloaded from a

service provider's remote location. Thus, there is no arguable disclosure in SUSSMAN that the

data stored in directory 9 is *composed of incoming and outgoing telephone calls* collected and

accessible prior to entering a personal secret access code. Moreover, while SUSSMAN discloses

the user can direct the telephone to dial any number listed in directories 9 and 10, there is no

arguable disclosure of storing telephone data related to at least one of incoming or outgoing calls

in memory 9, which is provided solely to receive directory data from the service provider.

Further, Appellant submits SUSSMAN's memory 9 fails to provide any arguable

disclosure of a public call list, composed of incoming and outgoing telephone calls that are

collected and accessible to all users during operation of the telephone prior to entering the

personal secret code, as recited in at least independent claim 16. Again, Appellant notes memory

9 of SUSSMAN is directory information downloaded from a directory service provider and there

is no disclosure this memory stores data related to incoming and/or outgoing telephone calls.

Moreover, Appellant notes, while SUSSMAN indicates the user directory information

can be prevented from display until entry of an appropriate identification code and password,

there is no arguable disclosure whether the on-line directory stored in memory 9 is accessible

before entry of the appropriate identification code and password. As SUSSMAN is silent as to

whether the telephone is operational and/or whether the on-line directory stored in memory 9 is

accessible to all users before entry of a personal secret code, Appellant submits this document

cannot anticipate the invention recited in at least independent claim 16.

Still further, as Appellant has shown memory 9 of SUSSMAN does not even arguably

correspond to the recited public call list, i.e., memory 9 of SUSSMAN is not populated by data

composed of incoming and outgoing calls, Appellant submits there is no arguable disclosure by

SUSSMAN of a public call list being accessible to all users during operation of the telephone

before entering the personal secret code, as recited in at least independent claim 16. In fact,

Appellant submits SUSSMAN does not even arguably disclose creating separate public and

private call lists, as recited in at least independent claim 16.

Thus, Appellant submits the above-noted features of the present invention, which are

recited in at least independent claim 16, are neither expressly nor implicitly disclosed by

SUSSMAN. Because SUSSMAN fails to disclose at least the above-noted features of the instant

invention, Appellant submits the Examiner has failed to establish an adequate evidentiary basis

to support an anticipation rejection under 35 U.S.C. § 102(b).

Independent Claim 23:

Finally, Appellant's independent claim 23 recites, *inter alia*, storing in the telephone, *for*

each of the plurality of users, private telephone data related to at least one of incoming and

outgoing telephone calls in a respective private list, wherein each respective private list is

associated with a personal secret access code, *allowing each of the plurality of users access to*

the public type of telephone data, preventing each of the plurality of users from accessing any of

the private telephone data until a valid personal secret access code is entered, and *allowing the*

user entering the valid personal secret access code to access the private telephone data

associated with the valid personal secret access code. Appellant submits that SUSSMAN fails

to render unpatentable at least the above-noted features of the invention.

Appellant notes SUSSMAN discloses an on-line subscriber telephone directory in which

a central directory service provider maintains a local directory and forwards directory updates to

subscribers at predefined intervals and times. The directory is stored in a memory 9 and can be

accessed by a user to select an individual or business to call. Moreover, a memory 10 is provided

to store a user's on-line personal telephone directories, and can include a list of frequently used

telephone numbers. This list is populated by the user browsing the downloaded read-only

directory 9, which is maintained by the Central Telephone Directory Service Provider 1, and

selects entries to add to a personal list in memory 10. *See* SUSSMAN, Column 6, lines 40 – 47.

From the disclosure of SUSSMAN, directory 9 is populated with data downloaded from a

service provider's remote location. Thus, there is no arguable disclosure in SUSSMAN that the data stored in directory 9 is related to at least one of incoming or outgoing calls. Moreover, while SUSSMAN discloses the user can direct the telephone to dial any number listed in directories 9 and 10, there is no arguable disclosure of storing telephone data related to at least one of incoming or outgoing calls in memory 9, which is provided solely to receive directory data from the service provider.

Further, Appellant submits SUSSMAN's memory 9 fails to provide any arguable disclosure of a public call list, composed of stored telephone data related to at least one of incoming and outgoing telephone calls, being accessible to all users, as recited in at least independent claim 23. Again, Appellant notes memory 9 of SUSSMAN is directory information downloaded from a directory service provider and there is no disclosure this memory stores data related to incoming and/or outgoing telephone calls.

Moreover, Appellant notes, while SUSSMAN indicates the user directory information can be prevented from display until entry of an appropriate identification code and password, there is no arguable disclosure whether the on-line directory stored in memory 9 is accessible before entry of the appropriate identification code and password. As SUSSMAN is silent as to whether the telephone is operational and/or whether the on-line directory stored in memory 9 is accessible before entry of an appropriate code and password, Appellant submits this document cannot anticipate the invention recited in at least independent claim 23.

Still further, as Appellant has shown memory 9 of SUSSMAN does not even arguably correspond to the recited public call list, i.e., memory 9 of SUSSMAN is not populated by data related to incoming and/or outgoing calls, Appellant submits there is no arguable disclosure by SUSSMAN of a public call list being accessible to all users, as recited in at least independent

claim 23. In fact, Appellant submits SUSSMAN does not even arguably disclose separate public

and private call lists, as recited in at least independent claim 23.

Thus, Appellant submits the above-noted features of the present invention, which are

recited in at least independent claim 23, are neither expressly nor implicitly disclosed by

SUSSMAN. Because SUSSMAN fails to disclose at least the above-noted features of the instant

invention, Appellant submits the Examiner has failed to establish an adequate evidentiary basis

to support an anticipation rejection under 35 U.S.C. § 102(b).

Because the applied reference of SUSSMAN fails to disclose, either expressly or

implicitly, at least the above-noted features of the independent claims, Appellant submits the

Examiner has failed to establish an adequate evidentiary basis to support an anticipation rejection

under 35 U.S.C. § 102(b). Accordingly, the Board is respectfully requested to reverse the

Examiner's decision to finally reject independent claims 1, 11, 16, and 23 under 35 U.S.C. §

102(b).

Dependent Claims:

For these reasons, Appellant respectfully submits that independent claims 1, 11, 16 and

23 are allowable over SUSSMAN or any proper combination of the prior art of record.

Moreover, Appellant submits that claims 2, 4, 12, 18, and 24 are also allowable over SUSSMAN

at least for the reason that these claims depend from allowable base claims and because these

claims recite additional features that further define the invention over the art or record. Thus,

Appellant submits SUSSMAN fails to anticipate the invention recited in at least claims 2, 4, 12,

18, and 24.

Moreover, for the following reasons, Appellant submits the following dependent claims

are separately patentable over SUSSMAN:

Claim 24:

As noted above, SUSSMAN fails to provide any arguable disclosure of storing both

public type and private type telephone data. Accordingly, Appellant submits the disclosure and

figures of SUSSMAN fail to positively disclose, *inter alia*, the telephone includes a display, a

keypad and *a storage device which stores both the public type and the private type of telephone*

data, as recited in claim 24.

Accordingly, Appellant submits that the Examiner has failed to provide an adequate

evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(b). Thus,

Appellant submits that the rejection of independent claim 24 is improper and should be

withdrawn.

Therefore, Appellant respectfully requests that the decision of the Examiner to finally

reject claims 1, 2, 4, 11, 12, 16, 18, 23, and 24 under 35 U.S.C. § 102(b) be reversed, and that the

application be remanded to the Examiner for withdrawal of the rejection over SUSSMAN and an

early allowance of all claims on appeal.

(B)   The Rejection of Claims 5 – 10, 13 – 15, 17, and 19 – 22 Under 35 U.S.C

§103(a) as being Unpatentable over SUSSMAN in View of AUSTIN is in Error, the

Rejection Should be Reversed, and the Application Should be Remanded to the

Examiner.

The Examiner asserts, if not inherent in SUSSMAN, AUSTIN discloses two modes, and

it would have been obvious to modify SUSSMAN to include a security feature described by

AUSTIN. Appellant traverses the Examiner's assertions.

The Examiner asserts the invention would be obvious, if not inherent in SUSSMAN.

With regard to the Examiner's assertions, Appellant submits in order for inherency to be present

the Examiner has the burden of showing that the result indicated by the Examiner is the

necessary result, and not merely a possible result. *In re Oelrich*, 212 U.S.P.Q. 323 (CCPA 1981);

Ex parte Keith et al., 154 U.S.P.Q. 320 (POBA 1966). The fact that a prior art article *may*

inherently have the characteristics of the claimed product is not sufficient. *Ex parte Skinner*, 2

U.S.P.Q.2d 1788 (BPAI 1986).

As the Board of Patent Appeals and Interferences states in *Ex parte Levy*, 17 U.S.P.Q.2d

1461, 1463:

> However, the initial burden of establishing a *prima facie* basis to deny
> patentability to a claimed invention rests upon the examiner. *In re Piasecki*, 745
> F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In relying upon the theory of
> inherency, the examiner must provide a basis in fact and/or technical reasoning to
> reasonably support the determination that the allegedly inherent characteristic
> *necessarily* flows from the teachings of the applied prior art. *In re King*, 801 F.2d
> 1324, 231 USPQ 136 (Fed. Cir. 1986); *W.L. Gore & Associates, Inc. v. Garlock,
> Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578,
> 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA
> 1976); *Hansgirg v. Kemmer*, 102 F.2d 212, 40 USPQ 665 (CCPA 1939). In order
> for inherency to be present it must be a necessary result, and not merely a possible

results. *Ex parte Keith and Turnquest*, 154 U.S.P.Q. 320 (B.O.A. 1966).

In the instant situation, the Examiner has provided no explanation or evidentiary support for his assertion the features of claims 6, 8 – 10, 14, 15, 17, and 19 – 22 are inherently disclosed in SUSSMAN. As the Examiner has not shown the features of claims 6, 8 – 10, 14, 15, 17, and 19 – 22 are the *necessary result* of the disclosure of SUSSMAN, the instant rejection is improper and should be reversed.

According to the Manual of Patent Examining Procedure (MPEP) §2142, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellant submits no proper combination of the applied art discloses or suggests each and every feature of the claimed invention.

With regard to the rejection under 35 U.S.C. § 103(a), Appellant submits it is not clear which features of SUSSMAN the Examiner is asserting would have been obvious to modify with the two modes of AUSTIN in order to render Appellant's invention obvious. Thus, Appellant submits the rejection of claims 6, 8 – 10, 14, 15, 17, and 19 – 22 are improper because it is a mere conclusory statement that is unsupported by any facts of the record, and this type of conclusory statement cannot serve to support a *prima facie* case of obviousness. The Supreme Court has held that *"rejections on obviousness grounds cannot be sustained by mere conclusory*

*statement*s; instead, there *must be some articulated reasoning with some rational underpinning*

to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. _____

(2007), quoting *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) [emphasis added]. In the

rejection of claims 6, 8 – 10, 14, 15, 17, and 19 – 22, the Examiner has provided no articulated

reasoning with rational underpinning to support the legal conclusion of obviousness. Instead, the

Examiner merely asserts that the claimed invention would have been obvious.

Accordingly, Appellant submits the instant rejection is improper under 35 U.S.C. §

103(a) and should be reversed and remanded to the Examiner for allowance.

AUSTIN discloses a method for limiting access to data stored in a cellular telephone, and

more particularly, is directed to a subsidy lock code for use in activating the cellular phone on a

designated cellular network. The subsidy lock code of AUSTIN may be particularly

advantageous to prevent an interceptor of cellular phone activation signals from cloning the

phone. AUSTIN further discloses a data configuration lock code that can also be utilized,

preferably after the cellular phone has been activated.

Appellant submits, even assuming, *arguendo*, it were obvious to modify SUSSMAN in

view of the disclosure of AUSTIN, as asserted by the Examiner (which Appellant submits it is

not), the asserted combination of documents would not render unpatentable the instant invention.

That is, the two modes identified by AUSTIN relate to protecting phone data from cellular signal

interceptors, not to users of the telephone. Thus, as the protection of data described by AUSTIN

is wholly unrelated to protection of any data described in SUSSMAN, no proper combination of

SUSSMAN in view of AUSTIN would have even arguably rendered obvious Appellant's

invention, as recited in at least independent claims 1, 11, 16, and 23.

Moreover, Appellant submits neither SUSSMAN nor AUSTIN discloses or arguably

teach, *inter alia, storing telephone data related to at least one of incoming and outgoing telephone calls* in at least one of a public call and private call list, *the public call list being accessible to any user during operation of the telephone,* and *limiting a user's access to the public telephone data in the public call list, until such time as the user of the telephone inputs a personal secret access code,* after which, the user has access to the public telephone data in the public call list and to private telephone data in the private call list of private telephone data that is associated with the inputted personal secret access code, as recited in at least independent claim 1, or, *inter alia, a public list containing public telephone data is accessible to all users during operation of the telephone,* and a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code, in which *access to said stored telephone data is limited to said public list containing public telephone data, until such time as the user enters said personal secret access code,* and after entering the personal secret access code, the user has access to said public telephone data contained in said public list and to a private list containing private telephone data that is associated with said inputted personal secret access code, as recited in at least independent claim 16, or, *inter alia,* creating *a private list containing telephone data associated with the personal secret access code entered by the user,* the telephone data, composed of information related to incoming and outgoing telephone calls, *collected and accessible only after entry of the associated personal secret access code,* and *creating a public list accessible to all users during operation of the telephone which contains telephone data,* composed of incoming and outgoing telephone calls, *collected and accessible prior to entering the personal secret access code,* as recited in at least independent claim 16; or, *inter alia,* storing in the telephone, *for each of the plurality of users, private telephone data related to at least one of incoming and outgoing telephone calls in a respective private list,* wherein each respective

private list is associated with a personal secret access code, *allowing each of the plurality of users access to the public type of telephone data, preventing each of the plurality of users from accessing any of the private telephone data until a valid personal secret access code is entered, and allowing the user entering the valid personal secret access code to access the private telephone data associated with the valid personal secret access code,* as recited in at least independent claim 23.

Because neither applied document teaches or suggests at least the above-noted features of Appellant's invention, Appellant submits that no proper combination of these documents can even arguably render unpatentable the invention recited in at least the independent.

For these reasons, Appellant respectfully submits that independent claims 1, 11, 16 and 23 are allowable over any proper combination of SUSSMAN in view of AUSTIN.

Dependent Claims:

Moreover, Appellant submits that dependent claims 5 – 10, 13 – 15, 17, and 19 – 22 are also allowable over any proper combination of SUSSMAN in view of AUSTIN at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the invention over the art or record. Thus, Appellant submits no proper combination of SUSSMAN in view of AUSTIN renders unpatentable the invention recited in at least claims 5 – 10, 13 – 15, 17, and 19 – 22.

Moreover, for the following reasons, Appellant submits the following dependent claims are separately patentable over SUSSMAN in view of AUSTIN:

Claim 5:

Appellant submits that claim 5 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present

invention. In particular, as neither SUSSMAN nor AUSTIN disclose or arguably identify storing the public telephone data and the private telephone data in the respective *public call and private call lists of public telephone data and private telephone data on a common list*, the *private telephone data being hidden from the user until the user inputs the personal secret access code*, Appellant submits no proper combination of SUSSMAN in view of AUSTIN can render unpatentable the invention recited in claim 5.

Accordingly, Appellant submits that the rejection of independent claim 5 is improper and should be withdrawn.

Claim 6:

Appellant submits that claim 6 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, as neither SUSSMAN nor AUSTIN disclose or arguably identify providing *two operating modes* of the telephone, a *first mode* that has no access restrictions, and a *second mode* with access restrictions, as recited in claim 6.

Accordingly, Appellant submits that the rejection of independent claim 6 is improper and should be withdrawn.

Claim 7:

Appellant submits that claim 7 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, as neither SUSSMAN nor AUSTIN disclose or arguably identify *rejecting an incoming call*, and *blocking* of any indication of the incoming call, *when a telephone number is designated as a protected telephone number*, as recited in claim 7. Moreover, neither applied document discloses or suggests the manner in which calls listed in a protected list are

handled as incoming calls.

Accordingly, Appellant submits that the rejection of independent claim 7 is improper and should be withdrawn.

Claim 8:

Appellant submits that claim 8 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, as neither SUSSMAN nor AUSTIN disclose or arguably identify *switching between the two operating modes* by manipulating a predetermined keyboard command, as recited in claim 8.

Accordingly, Appellant submits that the rejection of independent claim 8 is improper and should be withdrawn.

Claim 9:

Appellant submits that claim 9 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, as neither SUSSMAN nor AUSTIN disclose or arguably identify *the predetermined keyboard command* comprises manipulating one of a particular sequence of commands and a plurality of contemporary commands, as recited in claim 9.

Accordingly, Appellant submits that the rejection of independent claim 9 is improper and should be withdrawn.

Claim 10:

Appellant submits that claim 10 is allowable at least for the reason that it depends from allowable base claims and because it recites additional features that further define the present invention. In particular, as neither SUSSMAN nor AUSTIN disclose or arguably identify

delaying the switching between the two operating modes *until the user inputs the personal secret*

access code, as recited in claim 10.

Accordingly, Appellant submits that the rejection of independent claim 10 is improper

and should be withdrawn.

Claim 13:

Appellant submits that claim 13 is allowable at least for the reason that it depends from

allowable base claims and because it recites additional features that further define the present

invention. In particular, as neither SUSSMAN nor AUSTIN disclose or arguably identify an

inhibitor that *prevents at least one of a visual indication and an audible indication of an*

incoming call when a telephone number of said incoming call is *designated to be a private call*

corresponding to a personal secret access code that has not been inputted into said telephone by a

current user of said telephone, as recited in claim 13. Moreover, neither applied document

discloses or suggests the manner in which calls listed in a protected list are handled as incoming

calls.

Accordingly, Appellant submits that the rejection of independent claim 13 is improper

and should be withdrawn.

Claim 17:

Appellant submits that claim 17 is allowable at least for the reason that it depends from

allowable base claims and because it recites additional features that further define the present

invention. In particular, as neither SUSSMAN nor AUSTIN disclose or arguably identify

preventing the user from being notified of an incoming call when the telephone number of the

incoming call is *designated as a private telephone number* and the user that designated the

incoming call as a private telephone number is not a current user of the telephone, as recited in

claim 17. Moreover, neither applied document discloses or suggests the manner in which calls

listed in a protected list are handled as incoming calls.

Accordingly, Appellant submits that the rejection of independent claim 17 is improper

and should be withdrawn.

Claim 19:

Appellant submits that claim 19 is allowable at least for the reason that it depends from

allowable base claims and because it recites additional features that further define the present

invention. In particular, as neither SUSSMAN nor AUSTIN disclose or arguably identify

preventing the current user from being notified of an incoming call when the incoming call is

designated as a private telephone number associated with a personal secret access code that

differs from that of the current user, as recited in claim 19. Moreover, neither applied document

discloses or suggests the manner in which calls listed in a protected list are handled as incoming

calls.

Accordingly, Appellant submits that the rejection of independent claim 19 is improper

and should be withdrawn.

Claim 20:

Appellant submits that claim 20 is allowable at least for the reason that it depends from

allowable base claims and because it recites additional features that further define the present

invention. In particular, as neither SUSSMAN nor AUSTIN disclose or arguably identify

switching between a public operating mode and a private operating mode by manipulating a

predetermined command on a keyboard of the telephone, as recited in claim 20.

Accordingly, Appellant submits that the rejection of independent claim 20 is improper

and should be withdrawn.

Therefore, Appellant respectfully requests that the decision of the Examiner to finally reject claims 5 – 10, 13 – 15, 17, and 19 – 22 under 35 U.S.C. § 103(a) be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over any proper combination of SUSSMAN in view of AUSTIN and an early allowance of all claims on appeal.
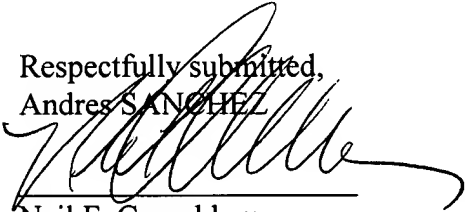
(C)   Conclusion

Claims 1, 2, 4, 11, 12, 16, 18, 23, and 24 are patentable under 35 U.S.C. § 103(a) over SUSSMAN; and Claims 5 – 10, 13 – 15, 17, and 19 - 22 are patentable under 35 U.S.C. § 103(a) over SUSSMAN in view of AUSTIN. Specifically, the applied art of record fails to anticipate or render unpatentable the unique combination of features recited in Appellant's claims 1, 2, 4 – 24. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's decision to finally reject claims 1, 2, 4, 11, 12, 16, 18, 23, and 24 under 35 U.S.C. § 103(a), and claims 5 – 10, 13 – 15, 17, and 19 - 22 under 35 U.S.C. § 103(a) and remand the application to the Examiner for withdrawal of the rejection.

Thus, Appellant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §102(b), and 35 U.S.C. §103(a), and that the present application and each pending claim are allowable over the prior art of record.

Respectfully submitted,
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Attachments: Claims Appendix
Evidence Appendix
Related Proceedings Appendix

8) CLAIMS APPENDIX

The following listing of claims is a listing of all pending claims in the instant application:

Listing of Claims

1. (Previously presented) A method for managing telephone data used with a telephone, comprising:

storing telephone data related to at least one of incoming and outgoing telephone calls in at least one of a public call and private call list, the public call list being accessible to any user during operation of the telephone; and

limiting a user's access to the public telephone data in the public call list, until such time as the user of the telephone inputs a personal secret access code, after which, the user has access to the public telephone data in the public call list and to private telephone data in the private call list of private telephone data that is associated with the inputted personal secret access code,

wherein both the private call list and the public call list are stored in the telephone.

2. (Previously presented) The method of claim 1, further comprising:

displaying on a display associated with the telephone at least one of the public call list of public telephone data and the private call list of private telephone data.

3. (Canceled)

4. (Original) The method of claim 1, wherein inputting of a personal secret access code comprises:

manipulating a predetermined key sequence on a keypad of the telephone to initiate an

operation to enter the personal secret access code.

5. (Previously presented) The method of claim 1, wherein the storing of telephone data comprises:

storing the public telephone data and the private telephone data in the respective public call and private call lists of public telephone data and private telephone data on a common list, the private telephone data being hidden from the user until the user inputs the personal secret access code.

6. (Previously Presented) The method of claim 1, further comprising:

providing two operating modes of the telephone, a first mode that has no access restrictions, and a second mode with access restrictions.

7. (Previously Presented) The method of claim 6, further comprising:

rejecting an incoming call, and blocking of any indication of the incoming call, when a telephone number is designated as a protected telephone number.

8. (Original) The method of claim 6, further comprising:

switching between the two operating modes by manipulating a predetermined keyboard command.

9. (Original) The method of claim 8, wherein the predetermined keyboard command comprises:

manipulating one of a particular sequence of commands and a plurality of contemporary commands.

10. (Original) The method of claim 8, further comprising:

delaying the switching between the two operating modes until the user inputs the personal secret access code.

11. (Previously presented) A telephone that manages integrally stored telephone data, comprising:

a memory that stores telephone data related to at least one of incoming and outgoing telephone calls; and

a public list containing public telephone data is accessible to all users during operation of the telephone;

a personal secret access code entry device that enables a user of the telephone to enter a personal secret access code,

wherein access to said stored telephone data is limited to said public list containing public telephone data, until such time as the user enters said personal secret access code, and after entering the personal secret access code, the user has access to said public telephone data contained in said public list and to a private list containing private telephone data that is associated with said inputted personal secret access code,

wherein both the private telephone data and the public telephone data are stored in the telephone.

12. (Original) The telephone of claim 11, further comprising:

a display that provides a visual indication of at least one of said public telephone data

contained in said public list and said private telephone data contained in said private list.

13. (Original) The telephone of claim 11, further comprising:

an inhibitor that prevents at least one of a visual indication and an audible indication of an

incoming call when a telephone number of said incoming call is designated to be a private call

corresponding to a personal secret access code that has not been inputted into said telephone by a

current user of said telephone.

14. (Original) The telephone of claim 13, wherein said personal secret access code is

inputted by manipulating a predetermined key sequence on a keypad of said telephone to initiate an

operation to enter said personal secret access code.

15. (Original) The telephone of claim 13, wherein said personal secret access code is

inputted by manipulating a predetermined sequence of simultaneous commands for a predetermined

time period on a keypad of said telephone to initiate an operation to enter said personal secret access

code.

16. (Previously presented) A method for managing data used with a telephone, comprising:

entering a personal secret access code into the telephone by a user of the telephone;

creating a private list containing telephone data associated with the personal secret access

code entered by the user, the telephone data, composed of information related to incoming and

outgoing telephone calls, collected and accessible only after entry of the associated personal secret

access code; and

creating a public list accessible to all users during operation of the telephone which contains

telephone data, composed of incoming and outgoing telephone calls, collected and accessible prior to

entering the personal secret access code,

wherein the telephone numbers in both the private list and the public list are stored in the

telephone.

17. (Original) The method of claim 16, further comprising:

preventing the user from being notified of an incoming call when the telephone number of the

incoming call is designated as a private telephone number and the user that designated the incoming

call as a private telephone number is not a current user of the telephone.

18. (Original) The method of claim 16, further comprising:

storing a plurality of personal secret access codes, the telephone numbers in the private list

being associated with various personal secret access codes, a current personal secret access code

entered into the telephone by a current user being limited to accessing telephone numbers in the

private list that are associated with the current personal secret access code entered by the current

user.

19. (Previously Presented) The method of claim 18, further comprising:

preventing the current user from being notified of an incoming call when the incoming call is

designated as a private telephone number associated with a personal secret access code that differs

from that of the current user.

20. (Original) The method of claim 16, further comprising:

switching between a public operating mode and a private operating mode by manipulating a

predetermined command on a keyboard of the telephone.

21. (Original) The method of claim 16, wherein entering the personal secret access code

comprises:

manipulating a predetermined key on a keypad of the telephone for a predetermined period of

time to initiate an operation to enter the personal secret access code.

22. (Original) The method of claim 16, wherein entering the personal secret access code

comprises:

manipulating a predetermined sequence of simultaneous commands on a keypad of the

telephone for a predetermined period of time to initiate an operation to enter the personal secret

access code.

23. (Previously presented) A method for managing telephone data using a telephone that can

be used by a plurality of users, the method comprising:

storing in the telephone public telephone data related to at least one of incoming and outgoing

telephone calls in a public list accessible to all users;

storing in the telephone, for each of the plurality of users, private telephone data related to at

least one of incoming and outgoing telephone calls in a respective private list, wherein each

respective private list is associated with a personal secret access code;

allowing each of the plurality of users access to the public type of telephone data;

preventing each of the plurality of users from accessing any of the private telephone data until a valid personal secret access code is entered;

allowing the user entering the valid personal secret access code to access the private telephone data associated with the valid personal secret access code; and

allowing another user entering another valid personal secret access code to access the private telephone data associated with another valid personal secret access code,

wherein each personal secret access code is distinct.

24. (Previously Presented) A telephone which can be used to practice the method of claim 23, wherein the telephone includes a display, a keypad and a storage device which stores both the public type and the private type of telephone data.

(9)   **EVIDENCE APPENDIX**

None.

(10)   **RELATED PROCEEDINGS APPENDIX**

None.